

REMARKS

The Office Action of January 31, 2003, has been received and reviewed.

Claims 1-23 were pending in the above-referenced application.

Claims 1-11 and 17-23 have been withdrawn from consideration. Each of these claims has been cancelled without prejudice or disclaimer to the subsequent pursuit of protection for the subject matter recited therein.

Claims 12-16 stand rejected.

Reconsideration of the above-referenced application is respectfully requested.

Preliminary Amendment

Please note that a Preliminary Amendment was filed in the above-referenced application on November 16, 2001, but that the undersigned attorney has not yet received any indication that the Preliminary Amendment has been entered into the Office file. If, for some reason, the Preliminary Amendment has not been entered into the Office file, the undersigned attorney would be happy to have a true copy thereof hand-delivered to the Office.

Rejections Under 35 U.S.C. § 102

Claims 12 and 14-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of U.S. Patent 5,172,622 to Sabin (hereinafter "Sabin").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Sabin teaches a table-top die cutting apparatus that includes a base that is configured to support a sheet of paper of other material to be die-cut, a frame extending upwardly from the base and supporting a die receiving element, and a "shifting mechanism" held in place by the frame and associated with the die receiving element. The shifting mechanism is basically a handle that, when moved, forces the die receiving element downward toward the base of the

die cutting apparatus and, thus, forces the cutting edges of a die through a sheet of paper or other material supported by the base.

Independent claim 12, as amended and presented herein, recites an apparatus for forcing a die through a sheet of material. The apparatus of amended independent claim 12 includes, among other things, a first member, a second member, and handles associated with the first and second members. The first member includes a die receiving surface and a die retaining element. The second member includes a substantially planar sheet supporting surface. The handles facilitate movement of at least one member of the first and second members toward the other member.

In contrast to the subject matter recited in amended independent claim 1, Sabin lacks any express or inherent description that the apparatus described therein may include more than one handle. Instead, the description of Sabin is limited to a die cutting apparatus with only a single handle. The apparatus of Sabin rests upon a table, which supports the same during operation thereof.

As Sabin does not anticipate each and every element of amended independent claim 1, it is respectfully submitted that, under 35 U.S.C. § 102(b), amended independent claim 1 is allowable over Sabin.

Claims 14-16 are each allowable, among other reasons, as depending from claim 12, which is allowable.

In view of the foregoing, it is respectfully requested that the 35 U.S.C. § 102(b) rejection of claims 12 and 14-16 be withdrawn.

Rejections Under 35 U.S.C. § 103(a)

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Sabin, in view of the teachings of U.S. Patent 5,313,885 to Winston (hereinafter "Winston").

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 13 is allowable, among other reasons, for depending from claim 12, which is allowable.

In addition, claim 13 is allowable since a *prima facie* case of obviousness has not been established thereagainst.

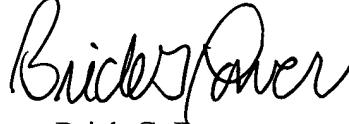
In particular, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to combine the teachings of Sabin and Winston in the manner that has been asserted. This is because one of ordinary skill in the art would not have been motivated to modify the die cutting device of Sabin with teachings from the art of hand-held ink stamps, to which Winston applies. Further, Sabin fails to provide any motivation or suggestion that the apparatus thereof may be used with hand-held dies. Nor does Winston provide any motivation or suggestion that the hand-held ink stamp described therein may be used in a machine. Based on the disparity between the teachings of these references, it appears that any motivation to combine them could only have been improperly based on hindsight gleaned from the disclosure of the above-referenced application.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claim 13 is respectfully requested.

CONCLUSION

It is respectfully submitted that each of claims 12-16 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing the allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



Brick G. Power
Registration No. 38,581
Attorney for Applicants
TRASKBRITT, PC
P. O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: (801) 532-1922

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